

REMARKS/ARGUMENTS

Re-examination and favorable reconsideration in light of the above amendments and the following comments are respectfully requested.

Claims 13 and 15 - 25 are pending in the application. Currently, all claims stand rejected.

By the present amendment, claim 13 has been amended to overcome the lack of proper antecedent basis objection raised by the Examiner. The claim has also been amended to corrected certain grammatical errors in the text of the claim.

In the office action mailed September 19, 2005, the Examiner rejected claims 13 and 15 - 25 under 35 U.S.C. 112, second paragraph. This rejection is now moot in view of the amendment to the preamble of claim 13.

Further in the office action, claims 13 and 15 - 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0172002 to Spira et al.; claims 20 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spira et al. in view of U.S. Patent No. 6,437,692 to Petite; claims 22 and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spira et al. and Petite and further in view of U.S. Patent No. 6,553,336 to Johnson et al.; claims 24 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Spira et al. in view of U.S. Patent No. 4,568,909 to Whynacht.

The foregoing rejections are traversed by the instant response.

The present invention relates to a system for remotely and automatically controlling, by a facilities management company, maintenance of facilities by a maintenance company with regards to a contract binding the maintenance company to the facilities

management company. The system comprises local monitoring units. Each local monitoring unit is installed in close proximity to at least one piece of the facilities and associated thereto. Each local monitoring unit comprises means for measuring operation parameters of the associated piece of facilities for detecting an operational state thereof, and control means for allowing a maintenance technician to real time notify the start and the end time of his maintenance or repair task performed on the associated piece of facilities or to notify that the associated piece of facilities is out of order for a long period because works are in progress. The control means is independent from the operational state of the associated piece of facilities. Each local monitoring unit further has means for being connected to a transmission network, and means for transmitting through the transmission network the detected operational state of the associated piece of facilities and the maintenance task start and end times. The system further has a first and a second computer. Each computer is connected to the local monitoring units through the transmission network and comprises means for receiving and processing the detected operational state and the maintenance task start and end times transmitted by the local monitoring units. The system further has means for storing all information transmitted by the local monitoring units. The first computer is available to the maintenance company and is used to manage the maintenance of the facilities, and the second computer is available to the facilities management company and is used to automatically control the maintenance and repair tasks performed by the technicians of the maintenance company on the facilities with regards to their contractual obligations.

With regard to the obviousness rejection of claims 13 and 15-19, this rejection fails because the instant application has

an earlier effective filing date. Applicant has claimed the benefit of a French priority application having a filing date of October 4, 2000. To perfect this priority, Applicant hereby submits an English translation of the French priority document. The Spira et al. application has a filing date of March 15, 2001. It claims the benefit of a provisional application; however, the provisional application does not comply with the requirements of 35 U.S.C. 112, first paragraph. The provisional application consists of two pages of text and a number of brochures. In its totality, the provisional application would not enable one of ordinary skill in the art to produce the disclosed and/or claimed Spira et al. invention without undue experimentation. It is further believed that the Spira et al. provisional patent application does not meet the written description or best mode requirements of 35 U.S.C. 112, first paragraph. Thus the Spira et al. patent application is only entitled to its actual filing date, which is after Applicant's effective filing date (the date of Applicant's priority application). Thus, Spira et al. is not available as a reference and the rejection(s) based upon Spira et al. fail.

Further, with regard to the obviousness rejection of claims 13 and 15 - 19 over Spira et al., an objective reading of Spira et al. shows that Spira et al. do not teach or suggest the system as set forth in the claims. Spira et al. does not teach or suggest a system comprising local units installed near machines to be monitored and comprising means for performing a diagnostic of the condition of the machine, and transmitting the diagnostic information via a network. The Examiner makes reference to "integrated sensors which are used to collect measurements continuously during operation ...", but does not say where the reference teaches or suggests connecting these sensors

to any local monitoring unit which comprises in combination means for measuring operation parameters of the associated piece of facilities, means for being connected to a transmission network, means for transmitting through the transmission network the detected operational state of the associated piece of facilities, and control means for allowing a maintenance technician to real time notify the start and end time of his maintenance task performed on the associated piece of facilities. One of ordinary skill in the art reading the Spira et al. reference would not find such a local monitoring unit having such a combination of elements.

It is submitted that the Examiner's interpretation of Spira et al. is unduly strained. In fact, the Examiner merely isolates some elements of Spira et al., taking them independently of the context from which they function in the Spira et al. system, and combines them artificially in an effort to meet the limitations of the claims. In other words, the Examiner's rejection is nothing more than an attempted hindsight reconstruction of the claimed invention.

According to the claimed invention, the local monitoring units are designed for allowing a maintenance technician to real time signal the beginning and end of his servicing on the facility, which information is transmitted to the maintenance and manger companies' computers. Spira et al. does not teach or suggest such functionality. In fact, Spira et al. can not implement such a real time transmission. Recognizing this, the Examiner states that there is an implied ability to track the start and end time of the work as well as the repair tasks performed during the maintenance by the repairman. Yet, Spira et al. never says that such an ability exists. As noted by the Examiner, there is no disclosure of any means, much less the

claimed means, for allowing a maintenance technician to real-time notify the start and the end time of the maintenance. Since there is no disclosure of such means and since there is no recognition in Spira et al. of real time notification, there is nothing in the cited and applied prior art which would motivate one of ordinary skill in the art to modify Spira et al. to provide such a capability. For this reason alone, claim 13 is allowable over the cited and applied prior art.

With regard to the rejection of claim 15, the Examiner contends that the functionality to prevent transmissions of malfunctions during an inspection is well known in the art. Yet the Examiner cites no secondary reference to establish this point. Applicant respectfully requests that the Examiner cite a reference teaching or suggesting this functionality and explain why one of ordinary skill in the art would be motivated to provide such functionality to the system of Spira et al. The mere fact that something exists in the prior art is not a sufficient basis to establish a prima facie case of obviousness. Further, the rejection makes reference to Reid's maintenance system; however, the Examiner has cited no reference to any Reid maintenance system.

With regard to claim 16, the Examiner has not addressed where in Spira et al. can find first and second computers connected to both a data base collecting all information and the information transmitted by the local monitoring units.

With regard to claim 17, the Examiner contends that displaying a fault signal when the items exceed their thresholds is obvious in light of Spira et al.'s disclosure. The cited portions in Spira et al. do not support the Examiner's contention. Since there is no explicit disclosure in Spira et al. of the claimed subject matter and since there is nothing in

Spira et al. which would motivate one of ordinary skill in the art to modify Spira et al. to provide such a feature, the claim is allowable. The Examiner's interpretation of what the inventors of a patent document meant to say is not a teaching or suggestion.

Claim 18 is allowable for the same reasons as claim 17. There is no explicit disclosure in Spira et al. of the claimed subject matter. Using performance indicators to evaluate effectiveness of the maintenance can mean many things. It is not a disclosure of the claimed subject matter.

Claim 19 is allowable for the same reasons as claim 13 as well as on its own accord.

The rejections of claims 20 - 25 on obviousness grounds is duly noted; however none of Petite, Johnson et al., and Whynacht cure the aforementioned deficiencies of Spira et al. Consequently, these claims are allowable for the same reasons as claim 13 as well as on their own accord.

For the foregoing reasons, the instant application is believed to be in condition for allowance. Such allowance is respectfully solicited.

A Notice of Appeal is appended hereto in the event that the Examiner maintains the rejections of record. Also appended hereto is a petition for a one month extension of time.

The instant amendment after final rejection should be entered for the purposes of appeal since it does not raise any new issue which would require further consideration and search by the Examiner. The only amendments to the claims are to overcome a lack of antecedent basis problem and grammatical changes to claim 13. Further, the amendments to claim 13 do not raise any issue of new matter.

Should the Examiner believe an additional amendment is needed to place the case in condition for allowance, the Examiner is hereby invited to contact Applicant's attorney at the telephone number listed below.

A check in the amount of \$310.00 is enclosed herewith to cover the cost of the Notice of Appeal and the one month extension of time. Should the Director determine that an additional fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on January 18, 2006.

